

REMARKS

No new amendments have been made to the present application. Thus, claims 1-19 are currently pending in the case. Further examination and reconsideration of the presently claimed application is respectfully requested.

Section 112, Second Paragraph, Rejections:

Statements in the Office Action reject claims 1-19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Ex Parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) MPEP 2173.05(e). As will be set forth in more detail below, the §112, second paragraph, rejection of claims 1, 3-5, 12, 13 and 17-19 is respectfully traversed. Claims 2, 6-11 and 14-16 are not specifically cited against in the Office Action; thus, Applicants assume that those claims are rejected merely for being dependent on a rejected base claim.

The Office Action alleges that claim 1 is indefinite because “[t]he location of the editor in the claim is unclear.” Claim 1 recites:

A system for web-based virtual advertising, comprising: a web server contained within a first computer and having a first vector graphics image and a web page containing a link to the first image; an ad server contained within a second computer and operably coupled to the web server by a network and having a second vector graphics image; a client contained within a third computer and adapted to receive the web page from the web server and to receive the first and second images from the web server and the ad server, respectively; and an editor adapted to overlay a portion of the first image with the second image.

Applicants wish to point out that the particular structure containing the editor (i.e., the location of the editor) need not be included in claim 1, since to do so would unduly narrow the claim from its desired scope. As set forth in MPEP 2173.04 “breadth of a claim is not to be equated with indefiniteness.” It is clear from the pending system claim that the presently claimed editor is adapted to overlay a portion of a first image (e.g., obtained from a web server) with a second image (e.g., obtained from an ad server). However, and as noted in the Specification, “[t]he editor is merely software executable within any execution unit, including the web server, ad server or client, or neither the web server, ad server or client but some execution unit altogether separate from the web server, ad server or client.” (Specification, page 6, lines 13-16, emphasis added). Since the presently claimed editor is intended to be “executable within

any execution unit", amending the claim to limit the editor to a particular structure or location would make the claim too narrow in structure and/or function. Instead of unduly limiting the scope of independent claim 1, possible locations for the editor are recited in dependent claims 3, 4 and 5. For at least these reasons, Applicants assert that the § 112 rejection of claim 1 is improper and that no amendments are necessary to clarify the present claim language.

With regard to claims 3 and 4, the Examiner suggests that if the editor is located in the web server (claim 3) or the ad server (claim 4), then the client will not receive the second image from the ad server (claim 3) or the first image from the web server (claim 4). *See, e.g., Office Action, page 2.* Applicants respectfully disagree. As recited in claim 1, a web server (contained within a first computer) has a first image, an ad server (contained within a second computer) has a second image, a client (contained within a third computer) is adapted to receive the first image (from the web server) and the second image (from the ad server), and an editor is adapted to overlay a portion of the first image with the second image. In light of such recitation, it is clear that both the client and the editor may have possession of (or at least access to) the first and second images. Claims 3 and 4 merely recite further limitations on the editor as operating within the web server or within the ad server, respectively. Claim 5 limits the editor to operating within the client. Even though the editor may not operate within the client in all embodiments of the invention, the particular location of the editor does not preclude the client from receiving a copy of the first and second images, as suggested by the Examiner. Instead, the web server, the ad server, or any other execution unit (other than the client) containing the editor may obtain its own copy of images that are separate and distinct from the images received by the client. *See, e.g., Specification, page 17, line 18 to page 18, line 2.* For at least these reasons, Applicants assert that the §112 rejection of claims 3 and 4 is improper and that no amendments are necessary to clarify the present claim language.

With regards to claim 5, the Examiner suggests that "claim 5 places the location of the editor in the client, however, if claim 5 was added to claim 1 then claims 3 and 4 would conflict with claim 1." (Office Action, page 3). Applicants wish to point out that the limitations of claim 5 are not included within claim 1, nor are claims 3 and 4 dependent on claim 5. Rather, claims 3, 4 and 5 are made separately dependent on claim 1 to recite various possible locations from which the editor may operate. It is irrelevant whether the hypothetical modification of claim 1 (e.g., to include the limitations of claim 5) would conflict with claims 3 and 4, since such modification has not been made. For at least these reasons, Applicants assert that the §112 rejection of claim 5 is improper and that no amendments are necessary to clarify the present claim language.

On page 3 of the Office Action, the Examiner provides a lengthy explanation for why, in view of claim 5, "the ad server and web server should not be operably coupled". The Examiner provides a similar explanation for the alleged indefiniteness of claim 19. Applicants are somewhat confused by the Examiner's explanation of claims 5 and 19 and request clarification before a response can be submitted.

With regard to claim 12, the Examiner suggests that "Claim 12 claims the web server and the ad server are computer program execution units while claim 1 now claims the web server and ad server to be first and second computers. It is not clear if the computer program execution units are intended... to replace the first and second computer limitations or are intended to be included within the first and second computers. Amendment to this claim is necessary to clarify the issue." (Office Action, page 3). Applicants respectfully disagree. First of all, present claim 1 does not claim "the web server and ad server to be first and second computers", as suggested in the Office Action (emphasis added). Instead, claim 1 recites a limitation on "a web server contained within a first computer" and "an ad server contained within a second computer" (emphasis added). Such recitation, however, does not necessitate that the web server and/or the ad server be equivalent to the first and second computers. Instead, and as recited in claim 12, the web server and the ad server are computer program execution units, which as recited in claim 1, are contained within the first and second computers. For at least these reasons, Applicants assert that the §112 rejection of claim 12 is improper and that no amendments are necessary to clarify the present claim language.

With regard to claim 13, the Examiner suggests that "[i]t is unclear where the overlaying is performed." (Office Action, page 3, emphasis added). The Examiner further suggests that the broadly claimed editor (or process of overlaying) renders claim 13 indefinite (Office Action, page 3). Applicants respectfully disagree. More specifically, Applicants are unaware of any basis in which the particular structure requested in the Office Action (i.e., the location where the overlaying is performed) must be added to claim 13. In fact, MPEP 2173.05(b) makes clear that "process or method claims are not subject to rejection by U.S. Patent & Trademark Office Examiners under 35 U.S.C. 112, second paragraph, solely on the grounds that they define the inherent function of a disclosed machine or apparatus." The method of claim 13 discloses a process of overlaying a portion of the first image with a second image obtained from a second computer, coupled to the first computer by a network, to obtain a modified first image. To avoid unduly limiting the scope of the claims, the presently claimed process of overlaying should not be limited to a particular structure or location. Therefore, it is not necessary define such a location in present

claim 13. For at least these reasons, Applicants assert that the §112 rejection of claim 13 is improper and that no amendments are necessary to clarify the present claim language.

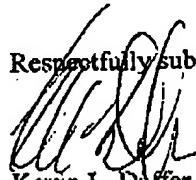
With regards to claims 17-18, the Examiner suggests, “[i]f the overlaying is in the first computer, see also claim 17, then the client computer will not be coupled to the second computer to obtain the second vector graphics image. If the overlaying is in the second computer, see also claim 18, then the client will not be coupled to the first computer to obtain the first vector graphics image.” (Office Action, page 3). With regards to claim 19, the Examiner suggests, “claim 19 places the location of the overlaying editor in the client, however, if claim 19 was added to claim 13 then claims 17 and 18 would conflict with claim 13. Claim 19 is indefinite because if the client computer performs the overlaying then the claimed second computer coupled to the first computer of claim 13 conflicts with claim 19 because...thus, in view of claim 19 the first computer and second computer should not be coupled to obtain a modified first image.” (Office Action, page 4). Due to the similarities between claims, reference should be made to the arguments presented above for claims 3-5. For at least the above reasons, Applicants assert that the §112 rejection of claims 17-19 is improper and that no amendments are necessary to clarify the present claim language.

CONCLUSION

No amendments were made to the present application. The rejection of claims 1-19 under 35 U.S.C. §112, second paragraph have been responded to. In addition, the prior art made of record but not relied upon is not considered pertinent to the Applicants disclosure. This response, therefore, constitutes a complete response to all issues raised in the Office Action mailed December 24, 2003. In view of the remarks traversing the rejections presented in the Office Action, pending claims 1-19 are in condition for allowance. If the Examiner has any questions, comments or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 03-2769/5468-05800.

Respectfully submitted,



Kevin L. Daffer
Reg. No. 34,146
ATTORNEY FOR APPLICANT

CONLEY ROSE, P.C.
P.O. Box 684908
Austin, Texas 78768-4908
(512) 476-1400
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JMF